

REMARKS

General:

Claims 1-9 were pending in this application. Claims 1-5 stand rejected. Claims 6-7 stand allowed. Claims 8-9 are withdrawn from consideration. Claims 10-14 are new. Claims 1-14 are pending in the application after this amendment.

Basis for new claims 10-14 will be found in original claims 1-5. No new matter has been added by this amendment.

Information Disclosure Statement:

A supplemental Information Disclosure Statement, based on a search report in the corresponding European Patent Application, is filed herewith.

Election/restriction:

The examiner maintains that the relationship between the process claimed in claims 1-7 and the product claimed in claims 8-9 is that of a product and a process of using that product, rather than that of a product and a process of making that product. In fact, it is neither. The article claimed in claim 8 is the intermediate product that is made by step (a) of claim 1, and used in step (b) of claim 1. It is therefore submitted that the examiner's application of MPEP § 806.05(h) is incorrect.

Even if MPEP § 806.05(h) does apply, it is submitted that the examiner's application of it is unreasonable. There must be a reasonableness requirement, otherwise almost any product and process of use could be held to be distinct, for example, on the ground that "the product as claimed can be used in a materially different process of using that product, such as a process of filling holes in the ground." In the present case, the examiner proposes forming a coated material by bonding the coating tape to the substrate with an adhesive. It is respectfully submitted that is not a reasonable alternative process. First, the article as claimed in claim 8 has the tape already applied, so that inserting an adhesive at this stage

would probably be impractical. Second, the coating tape comprises a powder mixture that is chemically reactive and likely mechanically weak, and that even if supported by an adhesive bond to the substrate would be unstable. Third, there is no discernable use for the end product of the examiner's proposed process, and thus no reason why anyone should carry out that process.

Reconsideration of the restriction requirement is respectfully requested.

35 U.S.C. § 103:

Claims 1-4 were rejected as obvious over U.S. Patent No. 4,726,101 (Draghi) in view of U.S. Patent No. 6,045,863 (Olson).

Draghi teaches a method of repairing cracks and surface defects and building up a worn surface of an article. The surface is covered with a tape including a mixture of metal alloy powder and binder. Multiple layers of the tape may be used to build up a desired shape (see col. 4, lines 49-50 and 61-66). The article is heated to a temperature at which the alloy powder tape material melts, fuses with and diffuses into the substrate alloy of the article (see col. 5, lines 2-3). The melted tape material fills any cracks (see col. 5, lines 4-5), leaving a void-free structure (see col. 4, line 14).

The examiner contends that Draghi teaches all of the limitations of claim 1 except for the composition of the aluminide tape, for which the examiner cites Olson. It is respectfully submitted that the examiner is mistaken.

Claim 1 recites a method for forming a coating on a surface bounding a contained space, comprising positioning a coating tape over the contained space, wherein the coating tape is in out of contact relation with the target surface. The examiner argues that a crack in Draghi's vane constitutes such a contained space, and the surfaces of the crack constitute such target surfaces. However, claim 1 ends with a heating step "to thereby form a[] coating on the target surface." Draghi neither teaches nor suggests to form a coating on the surfaces of the crack. Draghi teaches to fill the crack, and thereby to obliterate the surfaces of the crack.

Draghi does not teach or suggest a method for forming a coating on a target surface bounding a contained space, as recited in claim 1. That is clear, because Draghi's method does not result in a coating on a target surface bounding a contained space. At the end of Draghi's method, there is no contained space, and there is no target surface that could have a coating on it.

In order to emphasize the distinction, new claim 10 recites explicitly that the aluminide coating is formed on the surface bounding the contained space.

Further, it would not have been obvious to a person skilled in the art to substitute Olson's aluminide tape for Draghi's alloy tape as proposed by the examiner. As the examiner notes, one of the purposes of Draghi's process is to fill cracks. One of the purposes of Olson's process is to prevent the formation of cracks. It does not make sense to apply Olson's coating to a surface that is already so badly cracked as to need repair. *A fortiori*, it does not make sense to apply a crack-preventing coating to the walls of the cracks themselves, which is what the examiner's argument implies. And if the surface is not already cracked, then the examiner's argument does not apply, because the examiner is relying on the cracks to form the contained spaces recited in claims 1 and 10.

For all of the above reasons, it is believed that the present invention, as claimed in claims 1 and 10, is not obvious over the cited references. Claims 2-4 are dependent from claim 1 and claims 11-14 are dependent from claim 10. Without prejudice to their individual merits claims 2-4 and 11-14 are believed to be allowable for the same reasons as claims 1 and 10.

Allowable subject matter:

Claim 5 was objected to as dependent from a rejected base claim (claim 1). For the reasons set out above, claim 1 is believed to be allowable, and therefore claim 5 is believed to be allowable.

The examiner's indication of allowability of claims 6 and 7 is acknowledged with appreciation.

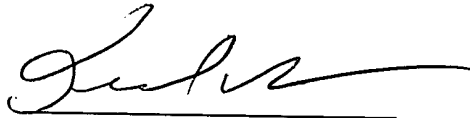
Conclusion:

For all of the above reasons, reconsideration of the examiner's rejections and objections, and an early notice of allowance of all claims, are earnestly solicited.

Respectfully submitted,

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